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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,270	04/26/2006	Dominic Berta	FE 6143 (US)	2471
34872	7590	03/30/2009		
Basell USA Inc. Delaware Corporate Center II 2 Righter Parkway, Suite #300 Wilmington, DE 19803			EXAMINER LENIHAN, JEFFREY S	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			03/30/2009 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/577,270

**Applicant(s)**

BERTA ET AL.

**Examiner**

Jeffrey Lenihan

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01/15/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 01/15/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action is responsive to the amendment filed on 01/15/2009.
2. The objections and rejections not addressed below are deemed withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Newly amended claim 14 states that component (c) of the claimed composition is obtained from a process comprising at least one metallocene catalyst corresponding to formulae (I) and (II). Claim 26 depends from claim 14, and states that component (c) is obtained by polymerizing in the presence of a metallocene compound comprising at least one cyclopentadienyl moiety which is  $\pi$ -bonded to a central metal. The examiner takes the position that it is unclear whether 1) claim 26 is intended to recite that component (c) is polymerized in the presence of two catalysts, or 2) the catalyst recited in claim 26 is the same catalyst described in claim 14. In the event that the latter was intended, the examiner notes that formulae (I) and (II) of claim 14 both depict a metal atom which is  $\pi$ -bonded to two cyclopentadienyl moieties; it is

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therefore unclear how the metal can be  $\pi$ -bonded to only one cyclopentadienyl moiety as recited in claim 26.

***Claim Rejections - 35 USC § 103***

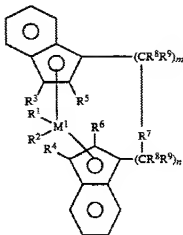
6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 14-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelliconi et al, WO 03/051984 (of record), in view of Winter et al, US5145819 (of record).

8. A discussion of the disclosure of Pelliconi may be found in paragraphs 5-22 of the previous Office Action, incorporated herein by reference.

9. Winter teaches the use of metallocene catalysts having the formula shown (abstract) (claims 14, 27), corresponding to claimed formula (I), for the polymerization of polyolefins (abstract) (claims 14, 27):



10. Pelliconi specifically teaches that the bridged bis-indenyl metallocene catalysts disclosed by Winter, US5145819, may be used in the production of the components of the polymer composition of WO 03/051984 (Page 5, lines 26-29). As Winter is explicitly cited, the examiner takes the position that it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to modify the polymer composition disclosed by Pelliconi by using the bridged bis-indenyl metallocene catalyst taught by Winter for the polymerization of the polymer components with the reasonable expectation of preparing a polymer composition having the balance of processability, mechanical properties, and optical properties disclosed by Pelliconi (Page 1, lines 6-8).

11. MPEP § 2112 recites that "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency under 35 U.S.C. 102, on *prima facie* obviousness under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same..." as that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). Applicant is therefore

required to provide factual evidence demonstrating that the properties used to define the polymer compositions of the instant application would not be present in the composition rendered obvious by the combination of Pelliconi and Winter.

***Response to Arguments***

12. The rejection of claims 14-26 under 35 U.S.C. 102(e) over Pelliconi et al, US2006/0047071, is withdrawn in view of applicant's amendment to independent claim 14.

13. Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Pelliconi et al, US2006/0047071, at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. The rejection of claims 14-26 under 35 U.S.C. 103(a) over US2006/0047071 is therefore withdrawn.

14. The rejection of claims as being unpatentable over Tanaka, US5115030, has been withdrawn in light of applicant's amendment to the independent claim 14.

15. Applicant's arguments filed 01/15/2009 have been fully considered but they are not persuasive. Applicant argues that Pelliconi teaches that the polymer components are prepared via the use of Ziegler-Natta catalysts, and therefore would be expected to have different properties from the claimed composition. The examiner notes however, that Pelliconi states that the polymerization reactions are "**preferably** carried out in the presence of stereospecific Ziegler-Natta catalysts." (Page 3, lines 25-26). Patent documents and prior art are not limited only to specific examples or preferred

embodiments. As noted above, Pelliconi explicitly states that the bridged bis-indenyl metallocene catalysts disclosed by Winter are suitable for use in the preparation of the components of the polymer composition of WO 03/051984. It would therefore have been obvious to one of ordinary skill in the art to use such a catalyst in practicing the invention of WO 03/051984.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Lenihan whose telephone number is (571)270-

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5452. The examiner can normally be reached on Monday through Thursday from 7:30-5:00 PM, and on alternate Fridays from 7:30-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemell/  
Primary Examiner, Art Unit 1796

Jeffrey Lenihan  
Examiner, Art Unit 1796

/JL/